



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/036,819 | 03/09/1998 | A. SAID EL SHAMI | 107-145D-C | 6406 |

7590 01/02/2003
JOSEPH E MUETH
8TH FLOOR
225 SOUTH LAKE AVENUE
PASADENA, CA 91101

EXAMINER

DEVI, SARVAMANGALA J N

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1645

DATE MAILED: 01/02/2003

28

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/036,819

Applicant(s)

El Shami

Examiner

S. Devi, Ph.D.

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Dec 18, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires three months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See the enclosed Attachment.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None

Claim(s) objected to: None

Claim(s) rejected: 56

Claim(s) withdrawn from consideration: None

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

S. Devi
S. DEVI, PH.D.
PRIMARY EXAMINER
ART UNIT 1645

Serial Number 09/036,819
Art Unit: 1645

ATTACHMENT TO ADVISORY ACTION

Item 5 of PTO-303.

The new claim 56 overcomes all pending rejections made for the canceled claim 55 except the 35 U.S.C § 112, second paragraph rejection made in paragraph 13(a) and the 35 U.S.C § 103(a) rejection made in paragraph 14 of the Office Action mailed 09/17/02 (paper no. 23). With regard to the 35 U.S.C § 103(a) rejection, the Office is fully compliant with *In re Zletz* mentioned by the Applicant. As to the individual elements recited in the instant claim, the Office is bound by the prior decisions of the Board both on the Appeal and the Interference. As to the combination of the elements which was not decided by the Board, the Office is not bound. However, the Office has fully considered whether the claimed combination is patentable over the Interference Count. The prosecution history reveals that Applicant did not move to pull out or exclude claims directed to individual elements, for example, sulfobromophthalein or testosterone, from the Interference count in the parent case. Regrettably, the Office cannot find in Applicant's favor because the Interference count (which corresponded to claims 1-27 of application 06/784,857, especially claims 17, 18, 10 and 23) reasonably renders obvious the instantly claimed combination in the method claim.